

REMARKS

The above-noted office action asserts both a restriction requirement and an election requirement.

A. THE RESTRICTION REQUIREMENT

With regard to the restriction requirement, the office action identifies two groups: Group I (claims 1-7, which are said to be directed to "a pressure regulator, classified in class 137, subclass 505.11), and Group II (claims 8-22, which are said to be directed to "a valve system and method of operating it, classified in class 137, subclass 486). Reconsideration is respectfully requested.

The office action characterizes the invention of Groups I and II as drawn to a subcombination and combination, respectively. Referring to M.P.E.P. § 806.05(c), the office action states that the inventions are distinct "if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations." With regard to the first element, the office asserts claims that the "combination as claimed does not require the particulars of the subcombination as claimed "because the details of the valving in the pressure regulator are not claimed in the combination." As for the second element, the office action states that "the subcombination has separate utility such as for regulating pressure independently in a fluid line."

The restriction requirement is traversed for the reasons stated below.

I. THE EFFECTS OF THE PATENT OFFICE'S POSITION ARE VARIOUS
ADMISSIONS CONCERNING PATENTABILITY

The effect of the position in the official action is that the Patent Office admits that the Group I claims are patentable over a disclosure of the combination of Group II, and *vice versa*. M.P.E.P. § 802.01 states that **the distinctness required for restriction means that the subjects, including "combination and part (subcombination) thereof ... ARE PATENTABLE (novel and unobvious) OVER EACH OTHER"** (emphasis with capital letters in original). (See also M.P.E.P. § 808.02, which states that where "related inventions are not patentably distinct as claimed, restriction ... is never proper.")

Thus, the effect of this restriction requirement, unless withdrawn, is that the Patent Office admits that the claimed pressure regulator of the Group II claims is patentable over any disclosure of a valve system having a regulator according to the Group I claims. *See, e.g.*, M.P.E.P. § 802.01. Likewise, the effect of this restriction requirement, unless withdrawn, is that the Patent Office admits that the claimed valve system with regulator of the Group I claims is patentable over any disclosure of a pressure regulator according to the Group II claims. *Id.* Each of independent claims 1, 8, and 16, however, includes similar elements, and therefore such admissions would appear to be improper.

In addition, where restriction is required, a double patenting rejection may not later be made, and therefore "it is imperative the requirement should never be made where related inventions as claimed are not distinct." M.P.E.P. § 806.

These positions are necessary to entry of the restriction requirement by the Patent Office and may be relied upon by the applicant during examination of this and continuing applications, unless the restriction requirement is withdrawn. If the examiner is not taking these positions, then it is submitted that the restriction requirement should be withdrawn upon reconsideration.

II. THE STANDARD FOR REQUIRING RESTRICTION HAS NOT BEEN MET BECAUSE THE CRITERIA OF DISTINCTIVENESS HAVE NOT BEEN DEMONSTRATED

The restriction requirement is improper because the criteria of distinctiveness in M.P.E.P. § 806.05(c) have not been demonstrated. To show distinctiveness, M.P.E.P. § 806.05(c) requires in part that “the combination as claimed does not require the particulars of the subcombination as claimed for patentability.” In addition, M.P.E.P. § 806.03 advises that:

“where the claims of an application define the same essential characteristics of a *single* disclosed embodiment of an invention, **restriction therebetween should never be required**. This is because the claims are but different definitions of the same disclosed subject matter, varying in breadth and scope of definition.”

Under these requirements, the restriction between Groups I and II is improper.

Independent claim 1, which is classified in Group I, is directed to a pressure regulator including a housing with an inlet and an outlet and a passage connecting the inlet to the outlet. A plug is connected in the housing and disposed in the passage, and is movable between open and closed positions. Claim 1 further recites a reverse pressure exhaust valve in the housing and extending between the inlet and the outlet. The reverse pressure exhaust valve is normally closed, but is openable when an outlet pressure exceeds inlet pressure by a predetermined amount.

Independent claim 8, which is classified in Group II, is directed to a valve system including a control valve, a valve actuator coupled to the control valve, and a regulator operatively associated with the valve actuator. The regulator includes an inlet, an outlet, and a movable element therebetween. The regulator further includes a reverse pressure exhaust valve adapted to connect the outlet to the inlet when the outlet pressure exceeds the inlet pressure by a predetermined amount.

Accordingly, both claims 1 and 12 have at least the following elements in common: (1) a regulator having an inlet and an outlet; (2) a throttling element (a “plug” in claim 1, a “movable element” in claim 8) disposed between the inlet and outlet; (3) a “reverse pressure exhaust valve” extending between the inlet and the outlet; and (4) placement of the reverse pressure exhaust valve in an open position in response to an outlet pressure that exceeds inlet pressure by a predetermined amount. Accordingly, independent claims 1 and 8 specify a similar regulator, albeit with varying breadth and scope with regard to certain features. Restriction between the claims of Groups I and II, therefore, is improper.

Furthermore, the reasons provided in the office action for the distinctiveness of the Groups are unfounded. The office action asserts that the combination as claimed “does not require the particulars of the subcombination as claimed for patentability.” (emphasis added) The elements of the regulator of claim 1 that are not specifically recited in claim 8 are: (1) a specific recitation of a regulator housing; (2) a specific recitation of a passage connecting the inlet to the outlet; (3) a specific recitation of a range of positions for the throttling element; and (4) a specific recitation that the reverse pressure exhaust valve is normally closed. The first three elements are at least inherently required in the regulator of claim 8. None of these elements, however, is required for patentability, as is necessary under the criteria of distinctiveness.

For the foregoing reasons, the applicant traverses the restriction requirement on the grounds that the criteria of distinctiveness between Groups I and II have not been demonstrated.

III. THE STANDARD FOR REQUIRING RESTRICTION HAS ALSO NOT BEEN MET BECAUSE SEARCH AND EXAMINATION OF THE ENTIRE APPLICATION CAN BE MADE WITHOUT SERIOUS BURDEN ON THE EXAMINER

The restriction requirement is improper on its face because it does not meet the requirement that search and examination of the entire application must be a serious burden on the examiner. M.P.E.P. § 803 states:

“If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.”

The applicant thus further traverses the restriction requirement on the ground that there is no evidence, or even allegation, that search and examination of the entire application would be a *serious burden* on the examiner, as required. Instead, the office action simply notes that the claims would be classified in different subclasses; namely the claims of Group I would be classified in class 137, subclass 505.11, while the Group II claims would be classified in class 137, subclass 486.

To the contrary, and in light of the common subject matter specified in the claims (as noted above), a complete search directed to the regulator having a reverse pressure exhaust valve as recited in the claims of Group I would require a search directed to the valve system having a regulator with a reverse pressure exhaust valve as recited in the claims of Group II, and vice versa.

Since search and examination of the entire application can be made without serious burden on the examiner, it would be wasteful of the time, effort, and resources of both the applicant and the Patent Office to prosecute these claims in separate applications. Search and examination of the two groups of claims together would be much more efficient than requiring the Patent Office and the applicant to do so separately in multiple applications.

IV. PROVISIONAL ELECTION WITH REGARD TO THE RESTRICTION REQUIREMENT

To satisfy 37 C.F.R. 1.143, the applicant hereby provisionally elects for examination on the merits, with traverse, the claims of Group I, i.e., claims 1-7. In doing so, the applicant does not intend to abandon the scope of the non-elected claims as originally filed, but may pursue the non-elected claims, either by petition for further review or in a divisional application, if the restriction requirement is not withdrawn upon reconsideration.

B. THE ELECTION OF SPECIES REQUIREMENT

Turning to the election of species requirement, the office action alleges that two patentably distinct species of the claimed invention exist. More specifically, it is asserted that claims 8-15 are directed to a valve system and comprise Invention A, while claims 16-22 are directed to a method of operating a valve system and comprise Invention B.

The office action characterizes Inventions B and A as drawn to a process and an apparatus for its practice. Referring to M.P.E.P. § 806.05(e), the office action states that the inventions are distinct “if it can be shown that either (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. The Office action concludes that the first element is met by alleging that “the process can be practiced differently by providing suitable vent in the actuator rather than in the regulator.”

The election requirement is traversed for the reasons stated below.

I. THE EFFECTS OF THE PATENT OFFICE'S POSITION ARE VARIOUS
ADMISSIONS CONCERNING PATENTABILITY

The effect of the position in the official action is that the Patent Office admits that the claims of each of Inventions A and B are patentable over the claims of each of the other species. M.P.E.P. § 808.01(a) states, "**Election of species should not be required if the species claimed are considered clearly unpatentable (obvious) over each other.**" (emphasis in original). (See also M.P.E.P. § 808.02, which states that where "related inventions are not patentably distinct as claimed, restriction ... is never proper.")

Thus, the effect of this election requirement, unless withdrawn, is that the Patent Office admits that the each of the claims of "Invention A" is patentable over any disclosure of the subject matter of the claims of "Invention B", and vice versa. *See, e.g.*, M.P.E.P. § 806.04, which states that "Where an applicant files a divisional application claiming a species previously claimed but nonelected in the parent case, pursuant to and consonant with a requirement to restrict, there should be no determination of whether or not the species claimed in the divisional application is patentable over the species retained in the parent case since such a determination was made before the requirement to restrict was made." Each of the claims currently pending in the application includes similar elements, and therefore such admissions would appear to be improper.

In addition, where restriction is required, a double patenting rejection may not later be made, and therefore "it is imperative the requirement should never be made where related inventions as claimed are not distinct." M.P.E.P. § 806.

These positions are necessary to entry of the election requirement by the Patent Office and may be relied upon by the applicants during examination of this and continuing applications, unless the election requirement is withdrawn. If the Examiner is not taking

these positions, then it is submitted that the election requirement should be withdrawn upon reconsideration.

II. THE CLAIMS OF EACH SPECIES ARE NOT MUTUALLY EXCLUSIVE,
AND THEREFORE THE ELECTION OF SPECIES REQUIREMENT IS
IMPROPER

According to M.P.E.P. § 806.04(f), "Claims to be restricted to different species must be mutually exclusive." Accordingly, for election to be proper, one claim must recite "limitations which under the disclosure are found in a first species but not in a second, while a second claim recites limitations disclosed only for the second species and not the first."

Ibid.

In the present application, at least independent claims 8 and 16 are not mutually exclusive. Specifically, claim 8 specifies a valve system including a regulator with a reverse pressure exhaust valve which connects an inlet and an outlet of the regulator in response to outlet pressure exceeds the inlet pressure by a predetermined amount. Claim 16 specifies a method of operating a control valve system including a regulator having a reverse pressure exhaust valve for relieving excess pressure from a valve actuator. According to the species identified in the office action, however, these claims would be classified differently (i.e., in "Inventions" A and B, respectively). Accordingly, applicants traverse the election requirement on the grounds that the claims of at least some of the species identified in the office action are not mutually exclusive.

III. THE STANDARD FOR REQUIRING RESTRICTION HAS NOT BEEN
MET BECAUSE THE CRITERIA OF DISTINCTIVENESS HAVE NOT
BEEN DEMONSTRATED

According to M.P.E.P. § 806.05(e), a process and apparatus for its practice can be shown to be distinct inventions if either or both of the following can be shown:

(A) that the process as claimed can be practiced by another materially different apparatus or by hand; or

(B) that the apparatus as claimed can be used to practice another materially different process.

The Office action fails to meet the burden of identifying a reasonable example that recites material differences between claims 8 and 16. The Examiner alleges that the process can be practiced by providing a vent in the actuator, rather than the regulator. This argument ignores the subject matter of the claims. Namely, claim 16 recites a method that requires pressure relief through the regulator. That a vent could be provided in an actuator is completely irrelevant to the claimed process. As such, the Examiner's example states a process that is different from the process as claimed, and therefore fails to provide a reasonable example of a material difference between claims 8 and 16. Consequently, the Examiner fails to meet the burden of demonstrating the need for election between species.

In addition, and contrary to the Examiner's assertions otherwise, the method of claim 16 cannot be practiced by another regulator that is materially different from that specified in claim 8. The process as claimed relieves actuator pressure through the regulator. The device as claimed provides structure for relieving pressure through the regulator. Accordingly, claims 8 and 16 are not patentably distinct, and the election requirement must be withdrawn.

IV. THE STANDARD FOR REQUIRING RESTRICTION HAS ALSO NOT BEEN MET BECAUSE SEARCH AND EXAMINATION OF THE ENTIRE APPLICATION CAN BE MADE WITHOUT SERIOUS BURDEN ON THE EXAMINER

The restriction requirement is improper on its face because it does not meet the requirement that search and examination of the entire application must be a serious burden on the examiner. M.P.E.P. § 803 states:

“If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.”

The applicants thus further traverse the restriction requirement on the ground that there is no evidence, or even allegation, that search and examination of the entire application would be a *serious burden* on the examiner, as required. Instead, the office action simply identifies the different species and their corresponding claims.

To the contrary, and in light of the common subject matter specified in the claims (as noted above), a complete search directed to the subject matter of the claims of Invention A would require a search directed to the subject matter of the claims of Invention B, and vice versa.

Since search and examination of the entire application can be made without serious burden on the examiner, it would be wasteful of the time, effort, and resources of both the applicants and the Patent Office to prosecute these claims in separate applications. Search and examination of the nine alleged Species of claims together would be much more efficient than requiring the Patent Office and the applicants to do so separately in multiple applications.

V. PROVISIONAL ELECTION WITH REGARD TO THE ELECTION REQUIREMENT

Should the Examiner withdraw the restriction requirement as argued in section A above but maintain the election requirement, applicants would elect the claims of Invention A (as well as claims 1-7) for prosecution on the merits. Should the Examiner maintain the restriction requirement, a provisional election of species would not appear to be needed since applicant has provisionally elected the claims of group I, which are not subject to the election of species requirement.

CONCLUSION

It is submitted that the present application is in good and proper form for allowance.

A favorable action on the part of the Examiner is respectfully solicited.

If, in the opinion of the Examiner a telephone conference would expedite prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,
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